

REMARKS

The foregoing amendments and these remarks are responsive to the Office Action dated August 1, 2005. Favorable reconsideration and allowance of the present application is respectfully requested in view of the foregoing amendments and these remarks.

Objection to the Drawings

The Office Action first objects to the drawings for not showing “the pressure-resistant coating ... positioned in the polyimide coating”, as recited in claims 4, 8 and 18. This objection has been overcome by canceling recitations from claims 4, 8 and 18. Nonetheless, applicant reserves the right, for example, to subsequently reinstate the recitations removed from claims 4, 8 and 18, and to add a new drawing figure which illustrates the pressure-resistant coating in the polyimide coating.

Rejection Under 35 U.S.C. §112

Next, the Office Action rejects claims 3, 4, 7, 8, 10, 11, 17 and 18 as being directed to subject matter that is not disclosed in the specification in a manner that is enabling to those of ordinary skill in the art. The Office Action more specifically indicates, with respect to the “passivation coating”, that the “specification does not describe any specific material or composition of this coating, and accordingly does not enable one skilled in the art to which it pertains to make and or use the invention.” The applicant respectfully disagrees with this rejection on grounds that those of ordinary skill in the art are reasonably knowledgeable about passivation coatings so that the inventions of claims 3, 4, 7, 8, 10, 11, 17 and 18 are sufficiently enabled. In this regard, the United States Court of Appeals for the Federal Circuit (“CAFC”) has indicated that those of ordinary skill in the art have knowledge of the field of art. More specifically, and for example, the CAFC has indicated that “Paragraph 1 [of 35 USC §112] permits resort to material outside of the specification in order to satisfy the enablement portion of the statute because it makes no sense to encumber the specification of a patent with all the

knowledge of the past concerning how to make and use the claimed invention.”¹ In this regard, and in support of having the enablement rejection withdrawn, it is respectfully requested that Examiner do a full-text search of U.S. patents and/or published U.S. patent applications and/or the internet (such as via the search engine accessible at www.google.com) for terms such as “passivation coating” and/or “passivation”. It is respectfully submitted that briefly searching in this manner, and a brief review of the results of the search, will provide ample evidence that those of ordinary skill in the art are sufficiently knowledgeable about passivation coatings such that the inventions of claims 3, 4, 7, 8, 10, 11, 17 and 18 are sufficiently enabled.

Rejections Over Prior Art / Claim Amendments

The Office Action indicates that independent claim 1 is unpatentable over US 5,904,426. In an effort to streamline prosecution, claim 1 has been amended so that it is more clearly distinguished from the ‘426 patent. For example, it is respectfully submitted that the ‘426 patent discloses imbedding particles in polyurethane, with the embedded particles serving as the lubricant, rather than the polyurethane serving as the lubricant. That is, the ‘426 patent neither teaches nor suggests that a polyimide coating is a permanent lubricant, even without other special lubricants being added. In contrast, claim 1 has been amended to recite that the “the polyimide coating is a permanent lubricant, even without other special lubricants being added”.^{2,3}

As further distinctions, amended claim 1 further refers to:

. . . immersing the at least one element into a prepolymer of polyimide so that the carrier material of the at least one element is coated with a film, and . . . then polymerizing the film to form the polyimide coating, with the polymerizing of the film including tempering the at least one element.

It is respectfully submitted that the ‘426 patent neither teaches nor suggests the portion of claim 1 quoted immediately above.

As another distinction, amended claim 1 refers to the polyimide coating having a

¹ *Atmel Corp. v. Information Storage Devices Inc.*, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999). See also *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 315 (Fed. Cir. 1983) and *S3 Inc. v. nVIDIA Corp.*, 59 USPQ2d 1745, 1749 (Fed. Cir. 2001).

² Support for this amendment can be found, for example, in original claim 6 and the specification, at page 2, lines 22-25. Referring to the specification is not intended to limit the scope of the claims to the disclosed embodiments.

³ Nonetheless, it is within the scope of the present invention to add an additional lubricant, for example as indicated by claim 15.

thickness of less than 30 μm . The applicant agrees with the Office Action's acknowledgement that the '426 patent does not teach this recitation of claim 1. On the other hand, the applicant respectfully disagrees with the Office Action's indication that the polyimide coating having a thickness of less than 30 μm is obvious. In support of applicant's traversal, it is noted that MPEP 2143 indicates, with emphasis added, that:

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

It is respectfully submitted that the '426 patent does not provide any suggestion or motivation with respect to claim 1's recitation of the polyimide coating having a thickness of less than 30 μm . Indeed, it appears that the only teaching or suggestion for the polyimide coating having a thickness of less than 30 μm comes from the present application, which indicates, for example, that making the polyimide coating very thin provides advantages with respect to hydrolytic stability and longer service life. However, and as indicated above, it is respectfully submitted that the Examiner's rejections should not be based upon hindsight to the present application.

In view of the foregoing, it is respectfully submitted that the rejection of the sole independent claim, claim 1, should be withdrawn. If for some reason it is deemed that the rejection of claim 1 should be maintained, then it is respectfully requested that the rejection be fully documented (i.e., that prima facie rejections be fully provided/documented) so that the applicant will have a fairer opportunity to rebut.

It is further respectfully submitted that the dependent claims are in condition for allowance because of their dependence from allowable independent claim 1, and because the dependent claims further patentably distinguish. As one example, it is noted that the Office Action indicates that claim 22 is not patentable; however, the Office Action provides no explanation as to why claim 22 is rejected. That is, a prima facie rejection is not provided for

claim 22. Accordingly, the applicant respectfully disagrees with the rejection of claim 22, and requests that this rejection be withdrawn, or as a minimum that it be fully substantiated so that the applicant will have a fairer opportunity to rebut. As an additional example, the Examiner's attention is directed to new claims 26 and 27.

Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for immediate allowance, and such action is solicited. If for some reason the Examiner deems that the present application is not in condition for immediate allowance, it is respectfully requested that the Examiner telephone the undersigned at 704-331-4904, in an effort to expedite prosecution.

Authorization

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment, to Deposit Account No. 09-0528.

Respectfully submitted

10/31/05
Date

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope address to: Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450, on October 3, 2005.

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